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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/768,629

01/29/2004

Karla Weaver

706198-2001

6763

7590 06/16/2011
Bingham McCutchen LLP
2020 K Street, NW
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EXAMINER

SCHMIDT, EMILY LOUISE

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

06/16/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/768,629	WEAVER ET AL.	
	Examiner	Art Unit	
	Emily Schmidt	3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 22, 2010 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorehead (US 5,984,902) in view of Ohringer (US 3,811,466) and Haarala et al. (US 2002/0156430 A1).

With regard to claim 29, Moorehead teaches a pressure activated valve for medical applications, comprising: a housing (Figs. 3 and 7 housing 112); and a flow control membrane comprising a first membrane (Figs. 3 and 7 element 128) and an annular base member stacked upon said first membrane (Figs. 3 and 7 element 124), said first membrane comprising a slit extending therethrough, wherein said slit opens when subjected to a pressure of at least a predetermined threshold level (Figs. 11-13, Col. 11 lines 12-41). Moorehead does not teach a plurality of curved slits. However, Ohringer teaches using a plurality of slits can be used to

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allow for greater flow (Col. 4 lines 31-35). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a plurality of slits in the device of Moorehead as Ohringer teaches this is beneficial as a means for controlling flow. Further, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art, *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Additionally, Haarala et al. teach a pressure activated slit valve which can equivalently be straight or curved (Figs. 5B and 8B). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use curved slits instead of straight in the device of Moorehead as in Ohringer because Ohringer teaches these to be art recognized effective equivalents.

With regards to claim 30, Moorehead teaches a membrane retention portion of the housing, the membrane retention portion being adapted to apply a retentive compression force to mounting portion (Fig. 3 generally indicated at 116, Col. 10 lines 2-4).

With regard to claim 31, Moorehead does not explicitly disclose the first membrane and base member are adhesively bonded. However, Moorehead does teach that member 124 can be retained effectively using adhesion (Col. 10 lines 11-12). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to bond the first membrane and annular base member with adhesive because Moorhead teaches that adhesive is suitable for use for retention and it is an art recognized effective way of securing two things together so as to maintain them in a desired position.

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4. Claims 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moorehead (US 5,984,902), Ohringer (US 3,811,466), and Haarala et al. (US 2002/0156430 A1) as applied to claim 29 above, and further in view of Fischer et al. (U.S. Patent 5,944,698).

With regard to claims 32 and 33, Moorehead teaches a pressure activated valve substantially as claimed. Moorehead differs from claims 5 and 6 in that it does not disclose specific thickness range for the membrane, though it does disclose that thickness variables are determined based on the pressure that will be experienced (Col. 7 lines 30-34). However, Fischer et al. teaches a membrane with a slit that opens due to fluid pressure as a result of a plunger being inserted into a syringe barrel (Fig. 3 elements 50, 52, Col. 6 lines 6-9) and that the membrane has a preferred thickness of about .01 inches to .05 inches (Col. 6 line 5). It would have been obvious to one of ordinary skill in the art to use a first membrane with a thickness of .01- .035 inches as in claim 5 or between .01 and .05 inches as in claim 6 in the device of Moorehead as such is an art recognized membrane thickness range as exemplified in the teachings of Fischer et al. Moreover, the membrane thickness range is taken to be a result effective variable routinely optimized to correspond to the pressure the membrane will be exposed to.

With regard to claim 34, Moorehead teaches a pressure activated valve substantially as claimed. Moorehead differs from claim 7 in that it does not teach the thickness of the mounting portion to be between 1 and 20 times the thickness of the lumen occluding portion. However, Fischer et al. teaches a preferred membrane thickness of about .01 to .05 inches (Col. 6 line 5). It would have been obvious to a person of ordinary skill in the art to apply the thickness range suggested in Fischer et al. to the first membrane and base member (Figs. 3 and 7 elements 128,

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124) in Moorehead as applied to claims 5 and 6. It directly follows that the thickness of the seating portion will be between 1 and 20 times the thickness of the lumen occluding portion.

Response to Amendment

5. The amendments to the claims have been entered and are sufficient to overcome the previous objections and rejections under 35 U.S.C. 112.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Schmidt whose telephone number is (571) 270-3648. The examiner can normally be reached on Monday through Thursday 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily Schmidt/
Examiner, Art Unit 3767

/KEVIN C. SIRMONS/

Supervisory Patent Examiner, Art Unit 3767